

REMARKS

In this response, Claim 20 has been amended to correct a misspelling of the word "wall" and to further specify that the claimed bicycle control device has a top surface defining a switch mounting recess therein. No new matter has been added. The amendment is fully supported by the originally filed application, including Figure 2 and originally-filed claims 1-4. No other claims have been amended. No claims have been canceled. Accordingly, claims 1 and 3-27 remain pending in the present application. Reconsideration of the above-identified patent application is hereby requested.

Rejection of Claims 1, 6, 9-11, 13, 17, 20, 23-25 and
27 Under 35 U.S.C. § 103(a) Based on Nagano in View of
Miike

The Examiner has rejected Claims 1, 6, 9-11, 13, 17, 20, 23-25 and 27 under 35 U.S.C. §103(a) as unpatentable over Nagano (U.S. Patent No. 4,489,307) ("Nagano") in view of Miike (U.S. Patent No. 5,345,051) ("Miike"). Reconsideration and withdrawal of the rejection is respectfully requested.

First, the combination of Miike and Nagano does not result in the claimed invention because their combined teachings do not provide a bicycle control device having an operation control button movable within a recess defined in the top surface of the control device such that the recess has a bottom wall and

a side wall connected to the bottom wall. The Examiner concedes that "Nagano does not disclose the switch mounting assembly, as claimed," but contends that it discloses a "bicycle control device for holding a computer switch having an operation control device having a switch (55, 56) mounted in a recess" Applicant respectfully disagrees with the Examiner's characterization of Nagano.

In Nagano, switches 55 and 56 are disposed in holes through a box 51. The box 51 is "open at the bottom." Nagano at 2:54. The top surface of the box 51 has a hole, not the claimed recess, and the box is the same size as the mounting surface 4 of the disclosed handle stem. Nagano at 3:52-56. Electric parts 52 are housed in the space within the box and the mounting surface along with switches 55 and 56. However, neither switch is disposed in a recess, much less a recess that conforms to the shape of the outer periphery of an operation control button that is movable within the recess.

The newly asserted Miike reference does not compensate for Nagano's deficiencies. Miike discloses a self-contained push button switch. Notwithstanding whether the insulating case 11 may be characterized as having a recess, one cannot combine Nagano and Miike to obtain the claimed invention without extensively altering the Nagano device. Claim 1 requires a recess defined in the top surface of a bicycle control device. Merely, attaching the Miike switch to the Nagano bicycle control

device would not result in the claimed invention because the switch mounting recess would not be defined in the top surface of the bicycle control device in the manner claimed. Moreover, incorporating the Miike switch into the Nagano device would require some means for connecting the Miike insulating case to the bicycle control device.

Similarly, the combination of Miike and Nagano does not result in the invention of claims 6 and 13. Those claims require a bicycle control device having a casing defining a switch mounting recess, wherein the recess has a bottom wall and a side wall connected to the bottom wall and wherein the recess has a shape conforming to the shape of an operation control button movable within the recess. The combination of Miike and Nagano does not result in a bicycle control device having a casing with the claimed configuration of recess and operation control button.

Claim 20 is directed to a method of installing a control switch. It has been amended to specify that the claimed bicycle control device has a top surface which defines a switch mounting recess therein. For the reasons stated above with respect to Claim 1, the combination of Miike and Nagano does not result in the invention of Claim 20. Dependent Claims 9-11, 17, 23-25 and 27 recite additional patentable features and are allowable as well.

Second, the Examiner has not identified any motivation or suggestion in the prior art for combining Nagano and Miike.

"When an obviousness determination is based on multiple prior art references, there must be a showing of some teaching, suggestion, or reason to combine the references." Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348 (Fed. Cir. 2000) (citations omitted). See also In re Stencel, 828 F.2d 751, 755 (Fed. Cir. 1987) ("Nor is obviousness established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made"). Because there is no basis for combining the references, reconsideration and withdrawal of the rejection is requested.

**Rejection of Claims 3-5 and 14-16 Under 35 U.S.C. §
103(a) Based On Nagano in view of Miike and further in
view of Abe**

The Examiner has rejected Claims 3-5 and 14-16 under 35 U.S.C. §103(a) as being unpatentable over Nagano in view of Miike, and in further view of Abe (U.S. Patent No. 6,073,730) ("Abe"). Reconsideration and withdrawal of the Examiner's rejection is respectfully requested.

The Examiner again indicates that the combination of Nagano and Miike applies to this rejection in the same manner as for Claims 1, 6, 9-11, 13, 17, 20, 23-25 and 27. The Examiner relies on Abe for its additional disclosure of a control device having two control buttons used for braking and shifting. As with the claims addressed above, Nagano and Miike do not disclose the configuration of control device, recess and operation control

button recited in Claims 3-6 and 14-16. Abe does not compensate for the deficiencies in the combination of Nagano and Miike. Thus, the combined references fail to disclose all of the elements of Claims 3-5 and 14-16 and do not render them obvious.

Moreover, the combination of Abe, Nagano and Miike is improper because the Examiner has not identified a motivation or suggestion for combining the references. "The absence of such a suggestion [to combine] is dispositive in an obviousness determination." Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997). "The mere fact that prior art could be modified in the manner proposed by the Examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification." Ex parte Dussaud, 7 USPQ2d 1818, 1820 (Bd. App. & Int'l 1988). As a result, the combination is improper. Because the Examiner has not identified such a suggestion, the combination is improper, and the rejection should be withdrawn.

The combination of Abe with Nagano and Miike is additionally improper because Abe specifically teaches away from the claimed invention. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984). Claims 3-5 and 14-16 require that the side wall and bottom wall are not printed circuit boards. Abe specifically teaches away by using side walls and bottom walls in a recess that are printed circuit boards. On that basis as well, combining Abe with Nagano and Miike is improper.

Rejection of Claims 7 and 21 Under 35 U.S.C. § 103(a)

Based on Nagano in View of Miike in Further View of

Seimitsu

Claims 7 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nagano in view of Miike, and further in view of Seimitsu (JP200268953) ("Seimitsu"). The Examiner again indicates that the combination of Nagano and Miike applies to this rejection in the same manner as for Claims 1, 6, 9-11, 13, 17, 20, 23-25 and 27. The Examiner contends that Seimitsu discloses the use of an adhesive to attach a portable clock to a fixed base.

Claim 7 depends from Claim 6 and Claim 21 depends from Claim 20. Seimitsu does not make up for the deficiencies of Nagano and Miike. Thus, Claims 7 and 21 are allowable for the same reasons that Claims 6 and 20 are allowable over the combination of Nagano and Miike. In addition, the Examiner has failed to provide any motivation or suggestion for combining the references. On that basis as well, the rejection should be withdrawn.

Moreover, Seimitsu is non-analogous art. "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."

In Re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Seimitsu

concerns the use of an adhesive to fix a vibration damper to a transparent base used in the liquid crystal panel of electronic devices such as a clock and telephone. It does not address control switches or techniques for mounting or attaching them. Thus, combining Seimitsu with Nagano and Miike is improper on that basis as well.

Rejection of Claims 8-9 and 22 Under 35 U.S.C. § 103(a)
Based on Nagano in View of Miike and in Further View of
Miyoshi

Claims 8-9 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nagano in view of Miike, and in further view of Miyoshi et al. (JP04048521) ("Miyoshi"). The Examiner again indicates that the combination of Nagano and Miike applies to this rejection in the same manner as for Claims 1, 6, 9-11, 13, 17, 20, 23-25 and 27.

Claims 8 and 22 depend from Claims 6 and 20, respectively, and further recite a hole in the bottom surface of the switch mounting recess and an elastic attachment arm on the operation control button, wherein the attachment arm is press fitted into the hole. Claim 9 depends from Claim 6 and further recites an elastic outer cover that is press fitted into the switch mounting recess.

Miyoshi does not compensate for the deficiencies in the combination of Miike and Nagano set forth above. Thus, Claims 8, 9 and 22 are allowable for the same reasons that Claims 6 and 20

are allowable over the combination of Miike and Nagano. In addition, the Examiner has not identified a motivation or suggestion in the prior art to combine Miyoshi with Miike and Nagano, and the rejection should be withdrawn on that basis as well.

Rejection of Claims 12 and 26 Under 35 U.S.C. § 103(a)
Based on Nagano in View of Miike and in Further View of
Hill

The Examiner has rejected Claims 12 and 26 under 35 U.S.C. §103(a) as being unpatentable over Nagano in view and Miike, and in further view of Hill et al. (U.S. Patent No. 5,745,438) ("Hill"). The Examiner again indicates that the combination of Nagano and Miike applies to this rejection in the same manner as for Claims 1, 6, 9-11, 13, 17, 20, 23-25 and 27.

Claims 12 and 26 depend from claims 11 and 24, respectively, and further recite the threaded engagement of a retention ring in the switch mounting recess. Hill discloses an electrostatic transducer and method of manufacturing the same. It does not compensate for the deficiencies of Nagano and Miike described above with respect to Claims 11 and 24. Thus, Claims 12 and 26 are allowable over the combination of Miike, Nagano and Miyoshi for the same reasons that Claims 11 and 24 are allowable over the combination of Miike and Nagano.

In addition, the assertion of Hill is improper. The portion of Hill relied upon by the Examiner is a threaded O-ring 16 that

mates with a threaded housing 11, thereby retaining an insulating member 17 in a recess 32. Not only is there no motivation or suggestion in the prior art for combining Hill with Miike and Nagano, but Hill does not involve control switches, or structures for retaining them within recesses. Thus, it is non-analogous art and its assertion is improper. See In Re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

Rejection of Claims 18 and 19 Under 35 U.S.C. § 103(a)

Based on Nagano in View of Miike and in Further View of Iteya

Claims 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nagano in view of Miike and in further view of Iteya (U.S. Patent No. 6,331,089) ("Iteya").

The Iteya reference identifies as its sole inventor Yoshihide Iteya, the sole inventor of the present application. The Examiner has not identified a specific provision of 35 U.S.C. § 102 under which the Iteya Patent constitutes prior art to the present application. Because the Iteya Patent issued on December 18, 2001, more than ten months after the present application was filed, it is not prior art under 35 U.S.C. § 102(b). Further, because the Iteya Patent and the present application were invented by the same person, the Iteya Patent is not prior art under 35 U.S.C. § 102(e). Accordingly, the Iteya Patent should be withdrawn as a reference.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

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